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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,452	08/24/2001	Edmund W. Figiel	1944.NVF	2230

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EXAMINER
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ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/938,452	Applicant(s) FIGIEL ET AL.	
	Examiner Joseph D. Anthony	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**FINAL REJECTION**

***Claim Rejections - 35 USC § 102***

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kielbania, Jr. et al. U.S. Patent Number 5,858,549 or Lee et al. U.S. patent Number 5,840,822.

Kielbania, Jr. et al teaches (hydroxyalkyl)urea (i.e. HAU) cross linking agents which contain a single urea group, at least two hydroxyl groups, and have at least two carbon atoms disposed between the urea group and each hydroxyl group, see abstract and column 2, line 66 to column 3, line 34. The HAU agents are used in compositions with a poly-functional molecule (i.e. PFM), which reads on applicant's "at least one rheology modifying agent" and applicant's "optionally a synthetic additive". Examples of such PEM agents are polymers and

copolymers of acrylic acid, (metha) acrylic acid, carboxylic-acid fictionalized urethane, vinyl acetates, etc., see abstract and column 2, lines 10-65. Applicant's claims are deemed to be anticipated over the compositions taught in Tables 1-11 in Example 12 both before cross-linking takes place and after cross-linking takes place. It must be noted that although applicant's specification does not directly state that crossing linking takes place between their HAU agent and "at least one rheology modifying agent" and/or "optionally a synthetic additive" such is deemed to be moot since the claims are directly open to compositions that are cross-linked or not cross-linked.

Lee et al teaches (hydroxyalkyl)urea (i.e. HAU) cross linking agents which contain a single urea group, a single hydroxyl group, and have at least two carbon atoms disposed between the urea group and the hydroxyl group, see abstract and column 2, line 43 to column 3, line 15. The HAU agents are used in compositions with a poly-functional molecule (i.e. PFM), which reads on applicant's "at least one rheology modifying agent" and applicant's "optionally a synthetic additive". Examples of such PEM agents are polymers and copolymers of acrylic acid, (metha) acrylic acid, carboxylic-acid fictionalized urethane, vinyl acetates, etc., see column 1, line 55 to column 2, line 42. Applicant's claims are deemed to be anticipated over the compositions taught in Tables 1-3 in Example 3 both before cross-linking takes place and after cross-linking takes place. It must be noted that although applicant's specification does not directly state that crossing linking takes place between their HAU agent and "at least one rheology

modifying agent” and/or “optionally a synthetic additive” such is deemed to be moot since the claims are directly open to compositions that are cross-linked or not cross-linked.

4. Claims 8 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kielbania, Jr. et al. U.S. Patent Number 5,858,549 or Lee et al. U.S. patent Number 5,840,822.

Keilbania, Jr. et al and Lee et al have both been described above. Applicant's claim 8 and 19-21 are deemed to be anticipated over said examples in each patent, because the crossed-linked product is deemed to read on a gel. In the alternative, applicant's claims are deemed to be obvious over Keilbania, Jr. et al and Lee et al only because Keilbania, Jr. et al and Lee et al do not expressly state that their cross-linked products are gels. It must be pointed out that applicant disclosure has set forth no definition of what is meant by a “gel”, such as a specific viscosity. The term “gel” is known to be a very broad term that can read on compositions of greatly varying viscosities etc.. It is also notoriously well known in the art that gels are very often made by the cross linking of polymers, such as by the process taught in Keilbania, Jr. et al and Lee et al..

### ***Response to Arguments***

5. Applicant's arguments filed 06/04/04 with respect to claims 1, 3-9 and 19-21 have been considered but are not deemed to put the application in condition for allowance for

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the reasons set forth above. Additional examiner comments are set forth next. The fact that neither Kielbania Jr. et al. nor Lee et al disclose the fire retardant nature of their taught compositions, such as when they are exposed to heat they generate carbon dioxide, is deemed to be totally irrelevant. Applicant is reminded that his elected invention is drawn to a composition and not to a method of extinguishing or suppressing a fire. It has long been established by the Courts that a new or unobvious method of use does not render an otherwise old or obvious composition patentable, see *In re Touminen* 213 USPQ 89 (CCPA 1982). At best applicant has "discovered" a new or undisclosed property of the applied prior-art materials (e.g. that they would generate carbon dioxide gas) when exposed to high heat, such as in a fire. Such a discovery also does not make an otherwise old or obvious composition patentable, see *in re Mod*, 161 USPQ 281 (CCPA 1969).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Examiner Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

6/28/04